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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/186, 962 11/05/98 RHOADS

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WM31/1221

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EXAMINER

COUSO, J

ART UNIT	PAPER NUMBER
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2621

17

DATE MAILED:

12/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/186,962	RH6A05
Examiner	J. L. Gars	Group Art Unit 2621

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 5 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 1/21/00 and 12/5/00.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 2 - 21 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 2 - 21 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

<input checked="" type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). <u>16</u>	<input type="checkbox"/> Interview Summary, PTO-413
<input type="checkbox"/> Notice of Reference(s) Cited, PTO-892	<input type="checkbox"/> Notice of Informal Patent Application, PTO-152
<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948	<input type="checkbox"/> Other _____

Office Action Summary

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell et al. (U.S. 5,721,788) in view of Shear (U.S. 4,977,594).

Powell discloses a method and system for digital image signatures.

With regard to claim 2, Powell describes obtaining audio or image files by downloading from plural computer sites (refer for example to column 1, lines 12-21 and column 2, line 60 through column 3, line 17); identifying plural of the obtained files having certain digital watermark dat embedded therein, and decoding the digital watermark data therefrom (refer for example to column 5, line 49 through column 6, line 43); by reference to the decoded digital watermark data, determining proprietors of each of the plural files (refer for example to column 6, line 44 through column 7, line 14); and sending information relating of the foregoing monitoring to the determined proprietors (refer for example to column 1, lines 12-49 and column 5, lines 44-54); wherein the proprietors of audio or image files are alerted to otherwise unknown distribution of their audio or image properties on computer sites (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

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Although Powell does not specifically state that the system is obtaining audio or image files from plural different Internet sites, the obtaining of audio or image files from plural different Internet sites is well known and widely utilized in the prior art.

Shear discloses a data base usage metering and protection system and method which specifically discusses the obtaining audio or image files from plural different Internet sites (refer for example to column 1, lines 33-49).

Given the teachings of the two references and the same environment of operation one of ordinary skill in the art at the time the invention was made would have been led in an obvious fashion to provide for obtaining audio or image files from plural different Internet sites as taught by Shear in the Powell system since both systems are primarily concerned with the usage of and protection of digital data. This is a routine design choice which fails to patentably distinguish over the prior art absent some novel and unexpected result.

In regard to claim 3, Powell describes decoding the digital watermark data with reference to public key data (refer for example to column 6, lines 18-43).

With regard to claim 4, Powell describes decoding the digital watermark data with reference to private key data (refer for example to column 6, lines 18-43).

As to claim 5, Powell describes identifying by including performing a domain transformation on data from at least certain of the files, yielding transformed data (refer for example to column 5, lines 29-36).

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In regard to claim 6, Powell describes identifying by including performing a matched filtering operation on the transformed data (refer for example to column 6, lines 44-53).

With regard to claim 7, Powell describes a domain transformation (refer for example to column 5, lines 29-36). Although the domain transformation is not a 2D FFT transform, to use this particular well known and widely used type of transform would have been obvious to one of ordinary skill in the art at the time the invention was made given the teachings of the Powell system.

As to claim 8, Powell describes a domain transform (refer for example to column 5, lines 29-36). Although the domain transformation is not a one-dimensional transform, to use this particular well known and widely used type of transform would have been obvious to one of ordinary skill in the art at the time the invention was made given the teachings of the Powell system.

In regard to claim 9, Powell describes the identifying further includes generating column integrated scan data for at least one oblique scan through an obtained image, and performing a transformation thereon (refer for example to column 5, lines 29-36). Although the domain transformation is not a one-dimensional FFT transform, to use this particular well known and widely used type of transform would have been obvious to one of ordinary skill in the art at the time the invention was made given the teachings of the Powell system.

With regard to claim 10, Powell describes the identifying includes transformation (refer for example to column 5, lines 29-36). Although the domain transformation is not one which

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computes power spectrum data, to use this particular well known and widely used type of transform would have been obvious to one of ordinary skill in the art at the time the invention was made given the teachings of the Powell system.

As to claim 11, Powell describes low-pass filtering (refer for example to column 5, lines 29-36).

In regard to claim 12, Powell describes analyzing a spectral characteristic of at least certain of the obtained files to identify the possible presence of digital watermark therein (refer for example to column 6, lines 18-43).

In regard to claim 13, Powell describes screening the obtained files to identify a subset thereof, and undertaking the decoding operation only for files in the subset (as clearly illustrated for example in figure 2).

With regard to claim 14, Powell describes the screening includes detecting a pattern in the file (as clearly illustrated for example in figure 2).

As to claim 15, Powell describes the decoding includes performing at least one statistical analysis. (refer for example to column 6, lines 18-43).

In regard to claim 16, Shear provides obtaining includes automatic computer downloading of image or audio files, without specific human instruction of particular files to be downloaded (refer for example to column 1, lines 33-49).

With regard to claim 17, Powell describes the decoded watermark data provides a reference to a registry database, and the method further includes obtaining additional data from

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the registry database by use of the reference, the additional data identifying the proprietor of the file from which the watermark data was decoded (refer for example to column 1, lines 12-14 and column 5, lines 44-54).

As to claim 18, Powell describes generating reports relating to results of the monitoring, and sending the reports to the determined proprietors (refer for example to column 1, lines 12-14 and column 5, lines 44-54).

With regard to claims 19-20, Powell describes obtaining audio or image files by downloading from plural computer sites (refer for example to column 1, lines 12-21 and column 2, line 60 through column 3, line 17); identifying plural of the obtained files having certain digital watermark dat embedded therein, and decoding the digital watermark data therefrom (refer for example to column 5, line 49 through column 6, line 43); by reference to the decoded digital watermark data, determining proprietors of each of the plural files (refer for example to column 6, line 44 through column 7, line 14); and sending information relating of the foregoing monitoring to the determined proprietors (refer for example to column 1, lines 12-49 and column 5, lines 44-54); wherein the proprietors of audio or image files are alerted to otherwise unknown distribution of their audio or image properties on computer sites (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

Although Powell does not specifically state that the system is obtaining audio or image files from plural different Internet sites, the obtaining of audio or image files from plural different Internet sites is well known and widely utilized in the prior art.

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Shear discloses a data base usage metering and protection system and method which specifically discusses the obtaining audio or image files from plural different Internet sites (refer for example to column 1, lines 33-49).

Given the teachings of the two references and the same environment of operation one of ordinary skill in the art at the time the invention was made would have been led in an obvious fashion to provide for obtaining audio or image files from plural different Internet sites as taught by Shear in the Powell system since both systems are primarily concerned with the usage of and protection of digital data. This is a routine design choice which fails to patentably distinguish over the prior art absent some novel and unexpected result.

In regard to claim 21, Powell describes obtaining audio or image files by downloading from plural computer sites (refer for example to column 1, lines 12-21 and column 2, line 60 through column 3, line 17); automatically identifying plural of the obtained files having certain digital watermark dat embedded therein, and decoding the digital watermark data therefrom (refer for example to column 5, line 49 through column 6, line 43); by reference to the decoded digital watermark data, determining proprietors of each of the plural files (refer for example to column 6, line 44 through column 7, line 14); and sending information relating of the foregoing monitoring to the determined proprietors (refer for example to column 1, lines 12-49 and column 5, lines 44-54); wherein the proprietors of audio or image files are alerted to otherwise unknown distribution of their audio or image properties on computer sites (refer for example to column 1, lines 12-49 and column 5, lines 44-54).

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Although Powell does not specifically state that the system is obtaining audio or image files from plural different Internet sites, the obtaining of audio or image files from plural different Internet sites is well known and widely utilized in the prior art.

Shear discloses a data base usage metering and protection system and method which specifically discusses the obtaining audio or image files from plural different Internet sites (refer for example to column 1, lines 33-49).

Given the teachings of the two references and the same environment of operation one of ordinary skill in the art at the time the invention was made would have been led in an obvious fashion to provide for obtaining audio or image files from plural different Internet sites as taught by Shear in the Powell system since both systems are primarily concerned with the usage of and protection of digital data. This is a routine design choice which fails to patentably distinguish over the prior art absent some novel and unexpected result.

3. Applicant's arguments filed November 21, 2000 have been fully considered but they are not persuasive.

The examiner has thoroughly reviewed applicant's arguments but firmly believes the cited references to reasonably and properly meet the claimed limitations. The combination of the cited prior art meets all the claimed limitations.

With regard to applicant's arguments, as set forth on pages 3-4 as to the applicability of Powell and Shear, the examiner respectfully disagrees. The examiner has reviewed and understands the legal cases cited by applicant, never-the-less the examiner feels that the rejection

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is both proper and reasonable. Specifically the examiner would like to point out that “the test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art” see In re McLaughlin, 170 USPQ 209 (CCPA) 1971. In the present case Powell clearly teaches that he is downloading an image from a remote site. While Powell does not specifically teach that the system is obtaining audio or image files from plural different Internet sites, the Powell system clearly infers that if the system obtains an image from one remote site at a certain time, then at a later time he can obtain another image from another remote site. While this alone may have been carried out by the single Powell reference, the examiner relied on a secondary reference, namely Shear, to show a system obtaining audio or image files from plural different Internet sites. Given these the teachings of the two references one of ordinary skill in the art at the time the invention was made would have been led in an obvious fashion to provide for this specific limitation in the Powell system.

With regard to applicant’s arguments on pages 4-5 of the response, which asserts “that the cited reference does not identify the problems solved by this invention” and “that the prior art teaches away from applicant’s claimed invention”, the examiner respectfully disagrees. The examiner will like to point out that “one cannot show non-obviousness by attacking references individually, where as here the rejections are based on combinations of references. See In re Keller, 208 USPQ 871 (CCPA 1981).

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As to applicant's arguments set forth on pages 5-6, wherein applicant argues that "no cited reference teaches, suggest or discloses the limitations of the claims", the examiner firmly disagrees. The cited references in combination properly and reasonably meet the claimed limitations as addressed in the rejection hereinabove. Applicant specifically mentions that the cited reference "Shear fails to teach, suggest or disclose a system that "generates report data for relaying to such proprietors""", the examiner firmly disagrees, as this aspect of applicant's claimed invention is set forth by Powell as described in column 1, lines 12-49 and column 5, lines 44-54.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

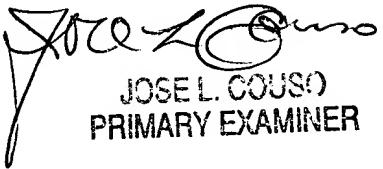
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jose L. Couso whose telephone number is (703) 305-4774. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for this Group is (703) 308-9051 or (703) 306-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-8576.


JOSE L. COUSO
PRIMARY EXAMINER

jlc

December 19, 2000